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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,380	12/06/2005	Albin A. W. Baccker	ADMS 3668	8375
321	7590	05/19/2008	EXAMINER	
SENNIGER POWERS LLP ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			O'HERN, BRENT T	
ART UNIT	PAPER NUMBER	1794		
NOTIFICATION DATE	DELIVERY MODE			
05/19/2008	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,380	<b>Applicant(s)</b> BAECKER ET AL.
	<b>Examiner</b> BRENT T. OHERN	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 17 March 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 7,9-11,13-17 and 21-25 is/are pending in the application.

4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 7,9-11,13-17,21,24 and 25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 7, 9-11, 13-17 and 21-25 with claims 22-23 withdrawn and 24-25 new.

## **WITHDRAWN OBJECTIONS**

2. The objections of claim 21 of record in the Office Action mailed 25 October 2007, page 4, paragraph 8 have been withdrawn due to Applicant's amendments in the Paper filed 17 March 2008

## **WITHDRAWN REJECTIONS**

3. The 35 U.S.C. 112, second paragraph, rejections of claims 21, 7, 9-11, and 13-17 of record in the Office Action mailed 25 October 2007, page 3, paragraph 7 have been withdrawn due to Applicant's amendments in the Paper filed 17 March 2008.
4. The 35 U.S.C. 103 rejections of claims 21, 7, 9-11, 13-14 and 16-17 as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428) of record in the Office Action mailed 25 October 2007, page 4, paragraph 9 have been withdrawn due to Applicant's amendments in the Paper filed 17 March 2008.
5. The 35 U.S.C. 103 rejections of claim 15 as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428) and Holt et al. (US 5,070,597) of record in the Office Action mailed 25 October 2007, page 7, paragraph 10 have been withdrawn due to Applicant's amendments in the Paper filed 17 March 2008.

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description** requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrases "without applying heat" in claim 24, lines 2 and 15 and "said first and second layers maintaining original sizes upon application of heat" in claim 24, line 10 is **new matter** as the original disclosure does not have support for the **negative limitations** and the maintaining original sizes upon application of heat limitations.

***Claim Rejections - 35 USC § 103***

7. Claims 21, 7, 9-11, 13-14, 16-17 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428).

Regarding claims 21 and 24-25, Baecker ('921) teaches a field liner (See col. 4, I. 44 and FIG-2, #26.) for protecting a timber pole against subsoil decay (See col. 4, I. 44 and col. 2, II. 54-56.), which includes a sheet element in the form of an elongated cylindrical sleeve of which one end is at least partially sealed (See FIG-2 and col. 5, II. 35-40 *wherein one end is at least partially sealed by heat shrinking*. Furthermore, *Applicant's invention is interpreted as field liner not a field liner attached to a pole and how the liner may be attached to a pole is a matter of intended use.*), the sheet element

being in the form of a laminate structure (See col. 3, l. 44.) including a first layer of material (See col. 2, ll. 46-53.), and a second layer of material (See col. 2, ll. 57-59.), with the first layer of material being a flexible (See col. 2, ll. 46-53.), liquid impermeable, non-biodegradable synthetic plastics film material (See col. 2, ll. 57-59.) that contains a dry film biocide therein (See col. 2, l. 61.) and defining an inner surface of the sleeve and the second layer of material being a flexible (See col. 2, ll. 46-53.), liquid impermeable (See col. 2, l. 58.), non-biodegradable (See col. 2, ll. 58-59.) synthetic plastics film material (See col. 2, ll. 57-59.) that is tear resistant (See col. 5, ll. 25-26.), and defining an outer surface of the sleeve (See col. 2, ll. 57-59.), however, fails to expressly disclose in which the second layer of material is provided with a strip of an adhesive substance positioned on the outer surface of the sleeve.

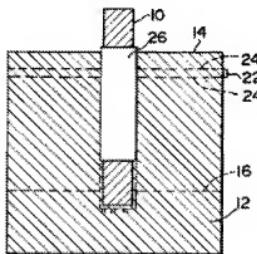


FIG 2

However, Steele ('428) teaches providing a strip of an adhesive substance positioned on the outer surface of a sleeve (See FIGs 3-4, and col. 3, ll. 25-35 wherein adhesive #26 is on the outer surface when wrapped around the pole,) for the purpose of holding down the liner and providing adhesion between the layers (See col. 3, ll. 34-35 and col. 4, ll. 31-36.).



FIG. 3

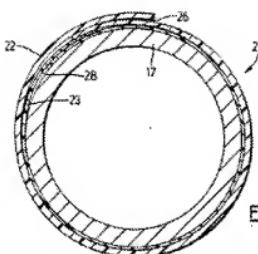


FIG. 4

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to apply an adhesive strip to Baecker's ('921) structure either instead of or in addition to shrinking as taught by Steele ('428) in order to provide a liner that can be held down and adhered to the other layers and members instead of or in addition to heat shrinking.

Note: Applicant's claims are directed towards a liner, not a pole wrapped with a liner or a roll of liners.

The phrase "which can adhere to an opposing region of the second layer of material when the sleeve is located on a timber pole and tightly wrapped around the timber pole" in claim 21, lines 10-12 is optional and directed towards an **intended use**, thus not further limiting in so far as the structure is concerned. Baecker ('921) is clearly capable of such.

The phrases "for securing the location of the sleeve on the pole" in claim 21, line 12 and "said plurality of field liners being wrapped in a roll" in claim 25, line 2 are

deemed to be statements with regard to the **intended use** and are not further limiting in so far as the structure is concerned (See MPEP 2111.02.). Baecker ('921) is clearly capable of being used as such.

The phrase "plurality of field liners" in the preamble of claim 25 not limiting as said language does not further limit the structure of the field liner. Furthermore, it would have been obvious to provide a roll containing more than one field liner as more than one pole are typically wrapped and rolls are a convenient way to support said material. Furthermore, see page 8, paragraph 3 of Applicant's Paper filed 17 March 2008 where Applicant acknowledges that new claims 24-25 are directed to the method of forming a cylinder and its use.

The phrases "adapted for adhering to an opposing region of the second layer when the sleeve is located on a timber pole and tightly wrapped around the timber pole" in claims 24 and 25, lines 12-14 of both claims does not limit the claims scope since said language **does not limit the claim to a particular structure** (See MPEP 2111.04.) and are statements with regard to the **intended use** and are not further limiting in so far as the structure is concerned (See MPEP 2111.02.). Baecker ('921) is clearly capable of being used as such.

Regarding claim 7, Baecker ('921) teaches a field liner in which the first layer of the sheet element is formed of polypropylene film (See col. 3, l. 15.).

Regarding claims 9-10 and 13-14, Baecker ('921) teaches a field liner in which the first/second layer of the sheet element contains an insecticide compound (pyrethroid insecticide, Deltamethrin) (See col. 3, l. 19-23.).

Regarding claim 11, Baecker ('921) teaches a field liner in which the second layer of the sheet element is formed of one of low density polyethylene and high density polyethylene (See *col. 2, l. 63.*).

Regarding claim 16, Baecker ('921) teaches a field liner in which the adhesive substance comprises an adhesive sealant.

Regarding claim 17, Baecker ('921) teaches the liner discussed above, however, fails to expressly disclose wherein the adhesive substance is covered by a peel-off strip.

However, Steele ('428) teaches wherein the adhesive substance is covered by a peel-off strip (See *FIGs-3-4, #26, col. 3, ll. 25-35 and col. 4, ll. 47-50.*) for the purpose of applying additional materials to the underlying layers (See *col. 4, ll. 47-50.*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with an adhesive substance covered by a peel-off strip as taught by Steele ('428) in order to provide a liner that is capable of applying additional materials to the underlying layers.

The phrase "that can form a part of the field liner and that can be peeled-off prior to or during application of the field liner onto a pole" in claim 17, lines 3-5 is optional language, thus not limiting.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428) and Holt et al. (US 5,070,597).

Baecker ('921) teaches a field liner which includes a first layer and a second layer of the sheet element (See *col. 3, l. 44.*), however fails to expressly disclose a third

layer of a flexible aluminum film that is vapour impermeable.

However, Holt ('597) teaches a flexible aluminum film (*See col. 7, ll. 53 and 56, flexible aluminum film.*) that is vapour impermeable (*See col. 7, l. 62 wherein the aluminum film provides a vapour barrier. Furthermore, films of aluminum are well known to possess vapour impermeable properties.*) for the purpose of providing a material that is flexible and a barrier to moisture (*See col. 7, ll. 56 and 62.*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with a flexible moisture water barrier aluminum as taught by Holt ('597) in order to provide a laminate that is flexible and a barrier to moisture.

#### **ANSWERS TO APPLICANT'S ARGUMENTS**

**9.** In response to Applicant's arguments (*p. 6, para. 5 to p. 7, para. 1 of Applicant's Paper filed 17 March 2008*) that Baecker ('921) field liner is fixed to a telephone pole, it is noted that Applicant's invention is for a field liner not for a field liner fixed to a telephone pole.

**10.** In response to Applicant's arguments (*p. 7, paras. 3-4 of Applicant's Paper filed 17 March 2008*) that Steele ('428) is non-analogous art and the sheet is subsequently secured by heat shrinking, it is firstly noted that Steele ('428) is cited for its means of attaching a liner to a cylindrical shaped structure, not the cylindrical shaped structure. Furthermore, both Steele ('428) and Baecker ('921) are classified in 428/34.9. Additionally Applicant's invention is not directed to a pole but rather a liner with adhesive.

11. In response to Applicant's arguments (*p. 7, para. 5 of Applicant's Paper filed 17 March 2008*) that Baecker ('921) does not teach adhesive and teaches heat shrinking, it is firstly noted that the Examiner concurs that Baecker ('921) does not teach adhesive and this is why Steele ('428) is cited. Additionally, it does not matter how Baecker ('921) secures its liner to a pole since Applicant's invention is not directed towards a liner secured to pole but rather a liner.

12. In response to Applicant's arguments (*p. 7, paras. 6-7 of Applicant's Paper filed 17 March 2008*) that there is not any motivation to combine Baecker ('921) and Steele ('428) as there is no reason to secure a liner by both heat shrinking and applying adhesive, it is noted that Applicant's invention does not require its liner to be applied to a pole, thus, Applicant's arguments are beyond the scope of the claim. Furthermore, whether a liner is secured to a pole by adhesive or shrink wrapping or a combination of the two does not matter, as long as there is securing while placing in the ground.

13. In response to Applicant's arguments (*p. 8, para. 2 of Applicant's Paper filed 17 March 2008*) that the references do not teach adhesive on a outer surface, it is noted that when Steele's ('428) liner is wrapped over itself on the pole the adhesive is in contact with both surfaces of the film, thus clearly on the outer surface.

14. In response to Applicant's comments (*p. 8, para. 3 of Applicant's Paper filed 17 March 2008*) that new claims 24-25 are directed to the method of forming a cylinder and its use, it is noted that Applicant's invention is a product, not a method and use.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT T. OHERN whose telephone number is (571)272-0496. The examiner can normally be reached on Monday, Tuesday and Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brent T O'Hern/  
Examiner, Art Unit 1794  
May 9, 2008

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794